REMARKS

Reconsideration is respectfully solicited.

Applicants respectfully traverse the rejection(s) of the prior claims 35 U.S.C. 102 and request reconsideration with respect to the prior claims and the amended claims. The support for recitation of Mn can be found on the passage from the last line of page 12 to line 3 of page 13. The support for the Markush group can be found on lines 2-7 of page 7. The amendments both narrow the issue and place the claims in better condition for appeal; and address the issue of whether a monomer and/or a dimer are a resin or a product of polymerization.

In applicants' view, the Briot et al reference does not describe polymerizing as recited in rejected Claim 4. As described at page 1519 Briot et al describes a cyclized monomer and a dimerization product resulting from the ether of entry 11 in the TABLE. Specifically, Briot et al states at page 1519,

> "Finally we examined one example of ether (entry 11) to show the selectivity displayed by catalyst 1. Whereas we observed only a dimerization product using Grubbs catalyst 2, the cyclized product was the only one obtained in good yield with the new catalyst."

In applicants' view, the only way to apply the Briot et al reference, against the original claims, requires the USPTO to use hindsight, specifically using applicants' claimed subject matter in the grounds of rejection. Hindsight is not only proscribed by the language of Section 103; but also hindsight is an irrelevant inquiry as to the issue of novelty in that USPTO policy in MPEP Section 2131 requires the reference to ***describe the subject*** matter under scrutiny. Not only does Briot et al. fail to describe a polymer but it also fails to describe how to make a polymer.

However, Compound/substrate 11 in Table 1 of Briot et al. is clearly excluded from the scope of the amended claims 1 and 4, since molecular weight of the dimerization product should be less than 1,500 where R is hydrogen or the group described in the amended claims. Therefore, in applicants' opinion, the present invention is both novelty and unobvious over Briot et al.

Applicants respectfully traverse the obviousness type double patenting rejections over U.S. 6939595 for the reasons set forth herein. However, to narrow the issue, a Terminal Disclaimer is filed concurrently. The U.S. Patent Office cited ***In re Vogel***, the seminal case in the area of obviousness—or judicially created—double patenting. That case dictates a claim by claim comparison at the claim element level, to adjudicate the issue. As Vogel indicates, the comparison is akin to the determination of an issue of infringement.

In applicants' view, US 6939595 presents no issue of double patenting. The claims of 6939595 are directed to an article of manufacture—an injection molded plastic magnetic recording medium substrate. Moreover, the patent claims define the allyloxymethyl styrene resin to include R which is selected from the group consisting of hydrogen, alkyl, cycloalkyl, aryl and aromatic heterocyclic. Comparison of the claims reveals that infringement of claims of 6939595 does not necessarily result in infringement of the claims of the instant application; and moreover infringement of the claims of the instant application does not necessarily result in infringement of the claims of the Patent. Lastly, Applicants find no basis for the U.S. Patent Office allegation that the "instant claims are generic to and encompass those in the patent claims." A Terminal Disclaimer by coassignees, Fuji Electric Device Technologies Co. Ltd. and Toshiyuki Kodaira is filed concurrently.

Applicants' representative, in Japan, has advised the following:

> That "the joint research agreement was made with written document as 'agreement for joint patent application'." The date of the agreement is September 11, 2002; the parties to the agreement were Toshiyuki Kodaira [Professor of Fukui University] and Kiyohiko Tsukamoto [General Manager, Peripheral Components Division, Electronics Company, Fuji Electric Co., Ltd.]

Applicants' representative, in Japan, has further advised:

> "The certifiable date of the claimed invention of this application is November 14, 2002, which is the priority date of the present application. Therefore, the claimed invention was made...after the date of the agreement, September 11, 2002."

Reconsideration and an early allowance are respectfully solicited.

Respectfully submitted,

Date: Dec 14 2006

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